

REMARKS

Applicants hereby add new claims 58-63. Accordingly, claims 1-42, 46, and 49-58 are pending in the present application.

Claims 1-3, 6-8, 11-13, 16-22, 24-25, 27-29, 33-37, 41-42, 51-53, and 55-57 stand rejected under 35 U.S.C. §103(a) for obviousness over U.S. Patent No. 5,842,118 to Wood, Jr. in view of U.S. Patent No. 5,649,296 to MacLellan et al. and U.S. Patent No. 3,733,602 to Cuckler et al. Claims 9-10 and 49-50 stand rejected under 35 U.S.C. §103(a) for obviousness over Wood in view of MacLellan and Cuckler and further in view of U.S. Patent No. 6,353,729 to Bassirat. Claims 4-5, 14-15, 23, 26, 30-32, 38-40, and 46 stand rejected under 35 U.S.C. §103(a) for obviousness over Wood in view of MacLellan and Cuckler and further in view of U.S. Patent No. 5,799,010 to Lomp.

With reference to claim 1, Applicants set forth numerous compelling arguments for patentability in the last response filed August 4, 2003. There is no motivation to combine the teachings of Cuckler and MacLellan with Wood in support of the 103 rejection for at least the numerous reasons set forth in Applicant's last response. For sake of brevity, the arguments are again incorporated herein but have not been repeated.

In the section of the Office Action entitled "Response to Arguments," the Examiner states apparently in support of the combination of the disparate teachings of Cuckler, Wood and MacLellan that these prior art references address the common arts pertinent to forward remote communication system and therefore they are combinable to teach the subject matters claimed. Applicants disagree.

Once again, Applicants start with the requirements for a proper *prima facie* 103 rejection. To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

The Examiner on page 3 states since all three references Wood, MacLellan and Cuckler address the common arts pertinent to forward remote communication system they are therefore combinable. Such bald, cursory statements fail to establish the requisite motivation to combine the disparate reference teachings.

Applicants refer the Examiner to MPEP 2143.01 8th ed.). Referring to MPEP §2143.01 (8th ed.), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. **The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.** MPEP §2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Turning to the alleged motivation cited on page 3 of the Action, the Examiner fails to define what a "forward remote communication system" is. Regardless, even if the prior art references are pertinent to a such a system, the MPEP makes abundantly clear that

such is deficient to establish proper motivation to combine reference teachings. The Examiner first fabricates a definition of a system to which the references are allegedly "pertinent to" and then uses such to justify the combination of reference teachings. If such were proper, the Examiner would apparently be able to combine one or more reference pertinent to wireless communications with any other reference pertinent to such communications. As made clear in the MPEP and by the Federal Circuit in *In re Lee* discussed in the previous response, **the mere fact that references may be combined is not sufficient unless the prior art suggests the desirability of the combination**. No desirability exists and but for the self serving cursory statements with respect to a system which the references are allegedly pertinent to, no position let alone a reasonable position has been established by the office with respect to the requisite motivation. The Examiner has improper relied upon Applicants' teachings to formulate the rejection; there is no motivation to combine the reference teachings and claim 1 is allowable for at this reason in addition to those formulated in the last response. Allowance of claim 1 is respectfully requested.

Further with respect to claim 1, the Office has failed to identify the reference teachings of MacLellan which allegedly disclose the claimed communication station despite Applicant's request and the authority of the C.F.R., MPEP and Federal Circuit. In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command.

When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final Action* if any claims are not found to be allowable.

There is no motivation to combine reference teachings and claim 1 is allowable for at least this reason. Even if the references are combined, the prior art fails to teach or suggest limitations of Applicants' claims. Claim 1 is allowable for at least these reasons.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

14 Still referring to the "Response to Arguments" section of the Office Action, Applicant now turns to the discussions therein with respect to claim 3 on pages 3-4 of the Office Action. The Office has failed to provide any explanation for the contradictory statements in the Action despite Applicant's last response. On page 6 of the Action with respect to claim 1, it is stated that Wood does not disclose a communication station. Thereafter, on page 8 of the Action , it is stated that Wood discloses a communication station including an adjustment of an electrical characteristic of the signal. The inconsistency illustrates the tenuous nature of the rejection. Further, the explanation set forth on page 20

4 of the Action that the rejection is proper "in view of the combinability of references" is deficient in view of the above-recited authority of the MPEP, C.F.R. and *In re Lee* of the Federal Circuit, and nonresponsive to Applicant's previous response. Clarification of the rejection of claim 3 is requested if claim 3 is not allowed.

With respect to claim 4 and the Examiner's response on page 4 of the Action, the bald cursory allegation that the references "are combinable" is deficient and non-responsive to Applicant's remarks in the last response. There is no motivation to combine the reference teachings in support of the rejection of claim 4, Lomp is non-analogous subject matter, and claim 4 is allowable for at least this reason.

With respect to claims 6-7 and the Examiner's response on page 4 of the Action that the rejection is proper "in view of the combinability of references" is deficient, contrary to the MPEP, C.F.R. and Federal Circuit authority, and is not responsive to Applicant's remarks. Likewise, with respect to claim 9, the statement that "prior art references are combinable within the spread spectrum processing environment" is deficient, contrary to authority and not responsive to Applicant's remarks. The fact that one or more reference may be drawn to a "spread spectrum processing environment" fails to provide the requisite motivation to combine reference teachings. Limitations of claim 6-7 and 9 are not shown nor suggested by the art and claims 6-7 and 9 are allowable.

The claims which depend from independent claims 6, 7, and 9 are in condition for allowance for the reasons discussed above with respect to the independent claim as well

as for their own respective features which are neither shown nor suggested by the cited art.

3 Referring to new claim 51, the communication station is further defined as configured to convert the forward link communication signal from a first communication medium type to a second, different, communication medium type. On page 15 of the Action, it is stated that a first modulated signal is within wired circuits 101-103 and corresponds to the digital signal out of the computer and the signal out of antenna 204 is the second communication medium type. Applicants disagree with the rejection. In particular, there is absolutely no teaching in MacLellan that any of application processor

101 or LAN 102 comprise a transmitter configured to provide a modulated signal in combination with the remotely located communication circuitry configured to convert the modulated signal from one medium type to another as claimed.

10 **Modulation occurs within modulator 202 and signals received within interrogator 103 from LAN 102 are not modulated signals.** Limitations of claim 51 are not shown nor suggested and claim

15 51 is allowable.

Referring to claim 53, the Office Action on page 15 states that a first modulated signal is within 101-102. However, the Office Action fails to identify any supporting teachings of MacLellan which allegedly disclose any of 101-102 or other circuitry communicating the recited modulated signal from the housing to the communication station via a wired medium as claimed. Once again, modulation occurs within modulator 202.

16 **Applicant respectfully requests clarification of the teachings relied upon as allegedly**

disclosing 101 or 102 of MacLellan as communicating a modulated signal if claim 53

is not allowed in the next Action. Claim 53 is allowable over the prior art of record.

3 Referring to claim 11, there is no motivation to combine the reference teachings for at least the reasons presented in Applicants' last response. The 103 rejection of claim 11 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 11 in the next Action.

The claims which depend from independent claim 11 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 21, there is no motivation to combine the reference teachings. The 103 rejection of claim 21 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 21 in the next Action for at least these reasons.

The claims which depend from independent claim 21 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 26, there is no motivation to combine the reference teachings. The 103 rejection of claim 26 is improper for at least this reason. Further, the prior art

relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 26 in the next Action.

Referring to claim 27, there is no motivation to combine the reference teachings. The 103 rejection of claim 27 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 27 in the next Action.

The claims which depend from independent claim 27 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 35, there is no motivation to combine the reference teachings. The 103 rejection of claim 35 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 35 in the next Action.

The claims which depend from independent claim 35 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 49, there is no motivation to combine the reference teachings. The 103 rejection of claim 49 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 49 in the next Action.

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Referring to claim 50, there is no motivation to combine the reference teachings.

The 103 rejection of claim 50 is improper for at least this reason. Further, the prior art relied upon in support of the 103 rejection is non-analogous. The rejection is improper for this additional reason. Applicants request allowance of claim 50 in the next Action.

Applicants hereby add new claims 58-63. Support for the new claims is found at least at Figs. 1 and 5-8 and the associated specification teachings of the originally-filed application.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 2/23/04

By: 

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